

REMARKS

Applicant would like to thank the Examiner for extending the courtesy of a face to face interview on November 12, 2008.

Reconsideration and allowance of the claims are requested in view of the above amendments and the following remarks. Upon entry of the response, claims 1, 3-7, 25-26, and 30-33 will be pending. Claims 1, 25, and 32 are currently amended. Support for the amendments can be found in the specification, for example in paragraphs 58 and 62. No new matter has been added. Claim 2 is canceled.

The above-listed amendments were made in accordance with the results of the interview between Applicant and Examiner on November 12, 2008. During the interview, Examiner noted that the inclusion of “no ownership interest” is a major point of novelty, and that the inclusion of the evaluation of the revenue share interest with a probabilistic model using a computer satisfies the test for statutory methods from In Re Bilski, 545 F.3d 943 (Fed. Cir. 2008)(en banc). Examiner indicated in the interview that amendments as submitted herein would place the claims in allowable form.

I. Rejections Under 35 U.S.C. §103 for Obviousness

The Office Action rejects claims 1, 3, 4, 25, 26, 30 and 31 under 35 U.S.C. § 103(a) as being obvious over a patent to Hoffman (U.S. Patent No. 6,253,191). Applicant respectfully traverses this rejection for at least the reasons stated below.

The method of claim 1 provides for a financier to finance an asset management firm where “no ownership interest in the asset management firm is received during the predetermined

period of time of the revenue share interest.” The financier may provide financing to the asset management firm, which may use the financing to fund operations of the asset management firm. In return, the financier may receive a revenue share interest in the revenues of the asset management firm, but no ownership interest in either the asset management firm or any of the assets owned by or invested in by the asset management firm. Applicant submits that Hoffman does not disclose or suggest this feature of claim 1.

As discussed with the Examiner during the interview of November 12, 2008, Hoffman provides for ownership of the Brownfields fund. While the Brownfields fund may insulate its investors from ownership of Brownfields, as stated in col. 5, line 64-col. 6, line 8 of Hoffman and cited by the Examiner, the investors still maintain an ownership interest in the fund itself. The structure of Hoffman provides insulation for the investors from the direct ownership of the Brownfields themselves, but not from the Brownfields fund. The investors provide capital to the Brownfields fund. The Brownfields fund then provides capital to special purpose vehicles which use the capital to fund Brownfields projects. The investors still have an ownership interest in the Brownfields fund, even if they have no ownership interest in the Brownfields. Thus, Hoffman does not provide a method of financing where no ownership interest is taken, as provided for in claim 1, since the investors necessarily take an ownership interest in the Brownfields.

Additionally, the Brownfields fund is not, itself, an asset management firm, but is instead an asset managed by an asset management firm, i.e. Fund Manager 115 in Hoffman. This is wholly different from the method of claim 1, where the financier provides financing to an asset management firm. In Hoffman, the investors’ capital is invested in an asset, the Brownfields, fund. The Brownfields fund is an asset, not a company of any sort. As an asset, the Brownfields

fund is managed by the Fund Manager 115. Nowhere does Hoffman disclose or suggest a method for the investors to provide their capital to the Fund Manager 115. Thus, Hoffman does not disclose or suggest “providing financing by the financier to the asset management firm.”

For at least the above reasons, claim 1 is allowable over Hoffman.

Claims 3, 4, 30 and 33 are dependent on claim 1. Therefore, claims 3, 4, 30 and 33 are allowable over Hoffman for at least being dependent on allowable claim 1.

Claim 25 is similar to claim 1, and is therefore allowable over Hoffman for the same reasons as claim 1.

Claims 26 and 31 are dependent on claim 25. Therefore, claims 26 and 31 are allowable over Hoffman for at least being dependent on allowable claim 25.

The Office Action rejects claims 5-7 under 35 U.S.C. § 103(a) as being obvious over Hoffman in view of a patent publication to Omayya (U.S. Patent Pub. 2006/0149562). Applicant respectfully traverses this rejection for at least the reasons stated below.

Claims 5-7 are dependent on claim 1. Claim 1 is allowable over Hoffman for at least the reasons stated above. Omayya does not cure the deficiencies of Hoffman with respect to claim 1. Therefore, claims 5-7 are allowable over Hoffman in view of Omayya for at least being dependent on allowable claim 1.

The Office Action rejects claim 32 under 35 U.S.C. § 103(a) as being obvious over Hoffman in view of Omayya further in view of a patent to Adams (U.S. Patent No. 6,154,730). Applicant respectfully traverses this rejection for at least the reasons stated below.

Claim 32 recites features similar to those in claim 1. Claim 1 is allowable over Hoffman, for at least the reasons stated above. Omayya and Adams do not cure the deficiencies of Hoffman

with respect to claim 1. Claim 32 is therefore allowable over Hoffman in view of Omayya further in view of Adams for at least the same reasons that claim 1 is allowable over Hoffman.

II. 35 U.S.C. §101 in light of Bilski

Applicant submits that the amendments to independent claims 1, 25, and 32, adding “evaluating the revenue share interest using the computer,” to the claims, is sufficient to meet the standards for patentability under 35 U.S.C. § 101 as viewed in light of the recent decision in In Re Bilski.

The test given in In Re Bilski for the patentability of a method is the “machine or transformation” test. The Federal Circuit’s decision in In Re Alappat, 33 F.3d 1526 (Fed. Cir. 1994)(en banc) held that programming a computer creates a new machine, “because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.” (emphasis added) In Re Alappat, 33 F.3d 1545. The decision in In Re Bilski did not disturb this holding from In Re Alappat.

The amendments to claims 1, 25 and 32 clearly tie the method step of “evaluating the revenue share interest” to a special machine, specifically, a computer running a program using a probabilistic model to evaluate a revenue share interest. Thus, claims 1, 25, and 32 are methods tied to a statutory machine as defined by In Re Alappat, and therefore satisfy the “machine or transformation” test for the patentability of methods from In Re Bilski. Claims 1, 25, and 32, are therefore statutory under 35 U.S.C. § 101 in light of In Re Bilski.

III. Miscellaneous

Applicants submit that the dependent claims pending herein are allowable at least by virtue of their dependency on independent claims which, as applicants describe above, are patentable over the cited references. Applicants reserve the right, however, to make supplemental arguments as may be necessary, because the dependent claims of the present application include additional features that further distinguish the claims from the cited references. A detailed discussion of these distinctions is believed to be unnecessary at this time in view of the fundamental distinctions already set forth in the above remarks.

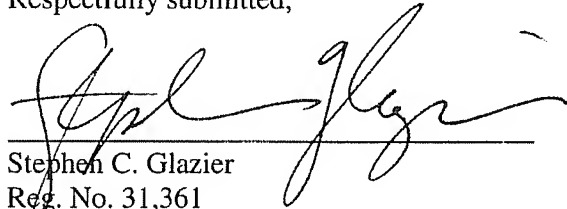
SUMMARY

Applicants submit that the present application is in condition for allowance and requests favorable action in the form of a Notice of Allowance. Should the Examiner believe that this application is in condition for disposition other than allowance, the Examiner is invited to contact the undersigned at the telephone number listed below in order to address the Examiner's concerns.

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Respectfully submitted,



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